

REMARKS

Claims 1-25 are pending in the present application. The Examiner has maintained the rejection of claims 1-25. Applicants respectfully request reconsideration of the instant application in view of the remarks set forth below.

In the Final Office Action mailed October 12, 2006, claims 1-8, 10-16 and 18-24 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Number 6,353,776 to Rohrl et al. (hereinafter *Rohrl*). Applicants respectfully traverse the Examiner's rejections.

Independent claim 1, among other things, calls for determining if an authorization signal authorizing a user terminal to communicate with a base station has been received from the base station at the user terminal within a specified period of time for the transmission of the authorization signal, and disabling a transmitter of the user terminal providing that the authorization signal has not been received within the specified period of time. The Examiner's application of *Rohrl* to claim 1 for the purposes of anticipation is flawed. For at least the reasons set forth below, claim 1 is thus allowable and its dependent claims 2-7 are also allowable.

In response to the Applicants' arguments, the Examiner reasserts that every element of claim 1 is taught by *Rohrl*. In particular, at page 2 of the Final Office Action dated October 12, 2006, the Examiner alleges that *Rohrl* discloses a base station 14, which is configured such that it records the time of signal emission by the transmitter unit 11, and the time of the reception of a response signal by the receiving unit 12 (in particular, of the checkbits that are relevant to the propagation time). The Examiner then alleges that real-time measurement takes place in the base station 14, during which the start is determined by the emission of checkbits by the base station 14 and the end is determined by the reception of the corresponding checkbits by the base station

14. According to the Examiner, the propagation time of the checkbits, i.e., from the emission by the transmitter unit 11 to the reception by the receiving unit 12 is measured and is compared with a maximum admissible reference propagation time. In this way, the Examiner asserts that the functions of ***Rohrl*** in the motor vehicle are controlled only if the propagation time of the code information (*i.e.*, checkbits) lies within the reference propagation time and the code information is authorized. Thus, the Examiner concludes that all the features of claim 1 are anticipated by ***Rohrl***. Applicants respectfully disagree for at least the reasons set forth below.

Rohrl at least does not teach disabling a transmitter of the user terminal, set forth in claim 1. In ***Rohrl***, the base station 14 controls functions in the motor vehicle. To control functions in the motor vehicle, the code information is authorized and transmitted within the response code signal from a portable code transponder, which is distinct from the base station 14. That is, ***Rohrl*** describes transmitting code information that is authorized within the response code signal from the transponder. As such, ***Rohrl*** describes controlling functions in the motor vehicle only if the propagation time of the code information (*i.e.*, checkbits) lies within the reference propagation time and the code information is authorized. See ***Rohrl***, col. 9, lines 23-26. The controlling of certain functions in the motor vehicle by ***Rohrl***, however, is not disabling a transmitter of the user terminal. As can be seen, ***Rohrl*** is completely silent about disabling a transmitter of the user terminal if the authorization signal is not timely received at the user terminal, as set forth in claim 1.

The Examiner alleges that ***Rohrl*** teaches disabling a transmitter of the user terminal if the authorization signal is not timely received at the user terminal, set forth in claim 1. ***Rohrl*** does not support the Examiner's argument because ***Rohrl*** controls functions in the motor vehicle that includes the base station after the portable code transponder 1 determines that a request or

interrogation code signal have been requested by an authorized base station 14. According to the Examiner, the user terminal that receives the authorization signal from the base station is equivalent to the portable code transponder 1 of ***Rohrl*** that sends the authorized code information to the base station 14. In ***Rohrl***, however, if the response code signal is requested by an unauthorized remote interrogation of the remotely disposed portable code transponder 1 a transmitter of the user terminal is not disabled, but rather control of a function for the base station at the motor vehicle is enabled or nor enabled. In particular, ***Rohrl*** enables or not enables a function for the base station at the motor vehicle upon non-recognizing of a response code signal as permissible by the portable code transponder 1. Although certain functions of the base station 14 may be disabled, the base station 14 retains its ability to transmit.

The Examiner further alleges that the ***Rohrl*** reference teaches receiving the authorization signal from the base station, as set forth in claim 1. The Applicants respectfully disagree and note that ***Rohrl*** does not teach receiving the authorization signal from the base station. ***Rohrl*** describes a technique that relates to an access control and driving an authorization device for a motor vehicle. To control at least one function of an object, ***Rohrl*** takes measures for preventing an unauthorized use or access to the object. In particular, ***Rohrl*** performs an authorization check by determining whether authorized code information is received from a portable code transponder 1, in a response signal at the base station 14. See ***Rohrl***, col. 11, lines 1-5. According to the Examiner, the “portable code transponder 1” shown in Figure 1 of ***Rohrl*** corresponds to the “user terminal” in claim 1. See Office Action, p. 3. The “base station 14” shown in Figure 1 shown in Figure 2 of ***Rohrl*** corresponds to the “base station,” as set forth in claim 1. In ***Rohrl***, the authorized code information item is received from a portable code transponder, which is not the base station. See ***Rohrl***, col. 11, lines 1-5. Instead, the portable

code transponder is a card (i.e., a smart card or the like). Moreover, the portable code transponder is used as an identification transmitter that automatically transmits back a response code signal to indicate that the code information is authorized after determining that a request or interrogation code signal has not been requested by an unauthorized remote interrogation from the base station to control functions in the motor vehicle that includes the base station. See **Rohrl**, col. 9, lines 22-26 and 40-45.

In rejecting claim 1, the Examiner further argues that the portable code transponder 1 indicating that the code information is authorized corresponds to receiving the authorization signal from the base station. According to the Examiner, because **Rohrl** teaches authenticating an interrogation request from the base station 14 at the portable code transponder 1 to indicate whether the code information is authorized before transmitting the response code signal from that portable code transponder 1 to the base station 14 to enable or not enable a function for that base station, **Rohrl** teaches determining if an authorization signal has been received from the base station for authorizing a user terminal to communicate. The Applicants respectfully disagree.

Applicants submit that determining whether the response code signal is requested by an unauthorized or authorized remote interrogation (as described by Rohrl) differs from determining if an authorization signal has been received from the base station for authorizing a user terminal to communicate with that base station (as set forth in the present application). Therefore, for reasons presented above, “determining if an authorization signal has been received from the base station for authorizing a user terminal to communicate” recited in claim 1 cannot and is not taught or suggested by “determining whether the code information contained in the response code signal transmitted from the transponder is authorized in response to receiving an

interrogation code signal from the base station,” as suggested by the Examiner. To the contrary, ***Rohrl*** teaches away from receiving the authorization signal from the base station and disabling a transmitter of the user terminal. For this reason alone, the claim 1 features differ from teachings indicated by the Examiner.

With respect to rejection of claims 8 and 18, Applicants respectfully submit that §102 rejection should be withdrawn since the Examiner fails to establish anticipation based on the teachings of ***Rohrl*** for at least the reasons noted above in the context of claim 1. Accordingly, claims 8 and 18 are allowable.

In the Office Action, claims 9 and 25 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over ***Rohrl*** in view of ***Lambert*** (U.S. Patent No. 5,642,380). Applicants respectfully disagree and submit that claims 9 and 25 cannot be rendered obvious in a *prima facie* manner in view of ***Rohrl*** and ***Lambert***, considered either alone or in combination. To establish a *prima facie* case of obviousness, the prior art reference (or preferences when combined) must teach or suggest all the claim limitations. Claim 9 sets forth, among other things, a MODEM having a software component with software running thereon and a hardware component that includes the signal detector, transmitter, and controller.

With regard to claim 9, the Examiner asserts that ***Rohrl*** teaches the determining and disabling features set forth in claim 9. The Examiner admits that ***Rohrl*** fails to disclose that the device comprises a modem having a software component with software running thereon and a hardware component that includes the signal detector, transmitter, controller and means for determining and the means for disabling. To remedy this fundamental deficiency in ***Rohrl***, the Examiner relies on ***Lambert***. The Examiner alleges that ***Lambert*** teaches a MODEM having a

software component with software running thereon and a hardware component that includes the signal detector, transmitter, and controller.

Lambert describes a MODEM in which the duration of the symbols of the modulated carrier-signal are variable. See **Lambert**, col. 2, lines 54-55. Unlike a conventional MODEM, in the MODEM described by **Lambert**, a feedback circuit from the outport TXD controls a variable divider 10 between a clock generator 12 and the input TXC, thus providing variable shift keying (VSK) of the transmitted data, as well as an output TXA controlling the transmitter, thus shifting the modulation function from the transmitter 6 to the SIO (Serial Input/Output) chip 2. See **Lambert**, col. 4, lines 15-21. However, **Lambert** is completely silent with regard to a MODEM having a software component with software running thereon, as set forth in claim 9.

The Examiner asserts that **Lambert** teaches the MODEM having a software component with software running thereon in col. 6, lines 8-26. This citation by the Examiner by no means supports the Examiner's contention that the MODEM described in **Lambert** corresponds to the MODEM of claim 9. In fact, **Lambert** indicates otherwise, since the described embodiments clarify that the MODEM only includes a feedback circuit that is not common with conventional MODEMS. See **Lambert**, col. 4, lines 12-21. Claim 9 depends from claim 8, so should be allowable for at least the reasons claim 8 is allowable.

Furthermore, the cited references including **Lambert** provide no suggestion or motivation to modify the prior art to arrive at Applicants' claimed invention. To the contrary, **Lambert** teaches away from the present invention. In particular, **Lambert** teaches an unconventional MODEM that uses a feedback circuit, which is not commonly included in a typical MODEM. Applicants respectfully submit that teaching use of a hardware component based MODEM with uncommon circuitry teaches away from the use of a MODEM having a software component. It

is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986). Accordingly, the §103 rejection of claim 9 is clearly improper. Applicants also respectfully request the allowance of claim 25 for at least the reasons set forth above.

Additionally, claim 17 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Rohrl** in view of **Newton's** Telecom Dictionary. Applicants' respectfully traverse the Examiner's rejections of claim 17 because **Newton's** Telecom Dictionary fails to describe or suggest all the claim 17 features as a whole.

The **Newton's** Telecom Dictionary is completely silent as to a device communicating with a base station of a communication system where an authorization signal authorizes the device to communicate with the base station. It is well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. Accordingly, the §103 rejection of claim 17 over **Rohrl** in view of **Newton's** Telecom Dictionary fails to establish that the prior art teaches or suggests the claimed invention in a *prima facie* obvious manner as a whole. For at least the aforementioned reasons, Applicants respectfully request withdrawal of the §103 rejection of claim 17 by the Examiner. Claim 17 depends from claim 8, so should be allowable for at least the reasons claim 8 is allowable.

In view of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4089 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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